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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,670	08/31/2001	Brad Pivar	81300520-0008-043	1117
26263 7590 03/17/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER				
ABEL JALIL, NEVEEN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/943,670

## Applicant(s)

PIVAR ET AL.

## Examiner

Neveen Abel-Jalil

## Art Unit

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9, 11-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 9, 11-24, and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26-November-2007 has been entered.
2. The amendment filed on 26-October-2007 has been received and entered. Claims 2-7, 9, 11-24, and 26 remain pending.
3. Applicant's response has overcome the previous claim objections.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 9, 11, and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, and 10 of copending Application No. 11/172743. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the instant application, for example, is directed to "selecting...sending...receiving...writing... determining.... performing...recoding..." document with digital signature and sending it to second user... just as similar to claim 1, of application '743 which recites "selecting....requesting...receiving... writing...providing to the second user... requesting,...writing...". The claims of the instant application anticipate those of copending application No. 11/172743.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7, 9, 11-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (U.S. Patent No. 6,796,489) in view of Yankovich et al. (U.S. Patent No. 6,704,906 B1).

As to claims 9, 11, and 18, Slater et al. discloses a system for interactive processing of a document comprising:

- a storage device (See Figure 1, shows storage devices);
- a processor connected to the storage device and to a first and second user on a computer network (See Figure 1, shows a computer connected to wide area network);
- a timing device connected (inherent processor clock in any computer) to the processor;
- the storage device storing a program to control the processor (See Figure 1, shows storage devices, 21, processing unit); and
- the program including instructions that direct the processor to control the:
  - sending of at least one selected document to a first user at a first location on a computer network (See column 9, lines 25-40);
  - receiving of at least one response to the at least one document from the first user (See column 9, lines 25-40);
  - writing of information obtained from the at least one response from the first user to at least one digital file (See column 9, lines 45-53);
  - determining of a first time stamp from the timing device corresponding to the receipt of the at least one response from the first user to the at least one request (See column 8, lines 24-50);

performing of a first digital signature routine on the at least one digital file to obtain an original digital signature (See column 8, lines 24-50);

recording of the first time stamp and first original digital signature associated with the at least one digital file in a database (See column 8, lines 24-50, also see Figure 3A, shows both signature on the document stored as a record in Database);

sending of at least one request determined from the selected document to a second user at a second location on a computer network (See column 10, lines 34-50);

receiving of at least one response from the second user to the at least one request (See column 3, lines 13-16);

writing of non-signature information obtained from the at least one response from the second user to at least one digital file (See column 3, lines 13-16);

performing a second digital signature routine on the at least one digital file to obtain a second digital signature of the at least one digital file (See column 10, lines 51-59); and

creating a second timestamp corresponding to a second time of submission of the information obtained from the at least one response from the second user (See column 13, lines 30-37, all digital signatures are stored with timestamp); and

sending the second digital signature and the second time stamp to a second remote location (See column 7, lines 50-55, and see column 17, lines 25-45, wherein both signature and time stamp are part of the digital document now that is being returned to the originator).

Slater et al. discloses the claimed invention but is not specific on how the document was originated, or the entry of non-signature information. Nor how it is routed to the second user.

However, Yankovich et al. from analogous art in the routable electronic form and digital signatures teaches:

sending of at least one request determined from a selected document to a first user at a first location on a computer network (See Yankovich et al. Figure 1, 114, wherein data entered by user reads on request and response);

writing non-signature information to document (See Yankovich et al. Figure 2, 8, and see Yankovich et al. Figure 9, 37B, fill-in);

sending of at least one request determined from the selected document to a second user at a second location on a computer network, and providing a second signature (See Yankovich et al. Figure 1, 120/122, route to users for approval, and see Yankovich et al. Figure 9, 37H, director signature for approval).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Slater et al. by the teachings of Yankovich et al. to include sending of at least one request determined from a selected document to a first user at a first location on a computer network; writing non-signature information to document; sending of at least one request determined from the selected document to a second user at a second location on a computer network because automatic routing based on authorized and user entry provides for collaborative and secure document processing environment (See Yankovich et al. column 1, lines 34-44).

As to claims 2, 12, and 19, Slater et al. as modified discloses wherein the computer network is the Internet (See Slater et al. column 6, line 57).

As to claims 3, 13, and 20, Slater et al., as modified discloses further comprising to determine whether the at least one response from the user to the least one request is valid and sending at least one additional request to the first user for additional non-signature information when the at least one response from the first user is invalid (See Slater et al. column 3, lines 13-16, wherein “valid” reads on “verification”).

As to claims 4, 14, and 21, Slater et al., as modified discloses further comprising to determine whether the at least one response from the second user to the at least one request is valid and sending at least one additional request to the second user for additional non-signature information when the at least one response from the second user is invalid (See Slater et al. column 16, lines 25-59, wherein if document is not valid or completed, more information can be requested from any user for recordation, and see Yankovich et al. column 2, lines 40-56).

As to claims 5, 15, and 22, Slater et al., as modified discloses further comprising to perform a routine determined from the selected document to provide feedback to the first user, the feedback determined in part by the at least one response from the first user to the at least one request (See Slater et al. column 10, lines 34-50).

As to claims 6-7, 16-17, and 23-24, Slater et al., as modified discloses further comprising to perform a routine determined from the selected document to provide feedback to the second user, the feedback determined in part by the at least one response from the second user to the at



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least one request (See Slater et al. column 16, lines 25-59, wherein if document is not valid or completed, more information can be requested from any user for recordation).

As to claim 26, Slater et al. as modified discloses wherein the first remote location is the same as the second remote location (See Slater et al. column 3, lines 14-17, wherein if the first and second location are the same then the document is just routed back to the originator or to a server where it was stored).

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 22-31 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

For complete list of cited relevant prior art, see PTO form 892.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil  
Primary Examiner  
March 11, 2008  
/Neveen Abel-Jalil/  
Primary Examiner, Art Unit 2165